



Attorney's Docket No. 09/343,696

Application No. 033462-001

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Patent

Attorney's Docket No. 033462-001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)

Tony PERVAN)

Application No.: 09/343,696)

Filed: June 30, 1999)

For: METHOD FOR JOINING BUILDING)
BOARD)

Group Art Unit: 3635

Examiner: Y. Horton

Confirmation No.: 8787

AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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JUL 13 2004

GROUP 3600

Sir:

In response to the Official Action of October 27, 2003 and the Official Action dated June 2, 2004, please amend the above-identified application as follows:

Amendments to the Specification begin on page 2 of this paper.

Amendments to the Claims begin on page 3 of this paper.

Remarks begin on page 11 of this paper.

AMENDMENTS TO THE SPECIFICATION:

Please replace the paragraph beginning on column 4, line 53 and ending on column 5, line 7 with the following amended paragraph:

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According to an especially preferred embodiment of the invention, a system is provided which permits precise joining of thin floor panels having, for example, a thickness of the order of 3 mm and which at the same time provides a tolerance-independent smooth top face at the joint. To this end, the strip is mounted in an [equalising] equalizing groove which is countersunk in the rear side of the strip panel and which exhibits an exact, predetermined distance from its bottom to the front side of the strip panel. The part of the strip projecting behind the groove panel engages a corresponding [equalising] equalizing groove, which is countersunk in the rear side of the groove panel and which exhibits the same exact, predetermined distance from its bottom to the front side of the groove panel. The thickness of the strip then is at least so great that the rear side of the strip is flush with, and preferably projects slightly below the rear side of the panels. In this embodiment, the panels will always rest, in the joint, with their [equalising] equalizing grooves on a strip. This levels out the tolerance and imparts the necessary strength to the joint. The strip transmits horizontal and upwardly-directed forces to the panels and down-wardly-directed forces to the existing subfloor.

AMENDMENTS TO THE CLAIMS:

Please amend claims 7, 8, 10, 11, 13, 17, 19, and 23 as follows:

7. (Amended) A system as claimed in claim 5, wherein

the strip is mounted in an [equalising] equalizing groove which is countersunk in the rear side of the panel and exhibits an exact, predetermined distance from its bottom to the front side of the panel,

the part of the strip projecting behind the adjacent panel engages a corresponding [equalising] equalizing groove which is countersunk in the rear side of the adjacent panel and which exhibits the same exact, predetermined distance from its bottom to the front side of the adjacent panel, and

the strip has at least such a thickness that the rear side of the strip is flush with the rear sides of the panels.

8. (Amended) A system as claimed in claim 7, wherein the strip has such a thickness that it is only partly received in the [equalising] equalizing grooves.

10. (Amended) A system as claimed in claim 9, wherein the mechanical connection between the strip and the panel comprises a gripping edge defined by two recesses in the rear side of the panel, and tongues[,] and lips [or the like] which are bent or punched from the strip and which press against opposite outer sides of the gripping edge.

11. (Amended) A system as claimed in claim 9, wherein the mechanical connection between the strip and the panel comprises a recess in the rear side of the panel, and tongues[,] and lips [or the like] which are bent or punched from the strip and which press against opposing inner sides of the recess.

13. (Amended) A system as claimed in claim 5, wherein the strip is made of a flexible[, preferably] resilient material[, such as sheet aluminum].

17. (Amended) A system as claimed in claim 1, wherein an underlay of floor boards, foam, or felt [or the like] is fixed to the rear sides of the panels.

19. (Amended) A system as claimed in any one of the preceding claims, wherein a sealing means[, such as a sealing compound, a rubber strip or the like,] is provided on the front side of the strip between the locking element and the first edge of the strip panel to seal against the adjacent panel.

23. (Amended) A system for providing a joint between adjacent building panels, comprising:
each of said building panels including a first edge and a second edge such that the first edge of each of said building panels forms a first mechanical connection with the second edge of an adjacent one of the building panels locking the first and second edges of

the building panels to each other in a first direction at right angles to a principal plane of the panels, and

a locking device arranged on a rear side of the building panels forming a second mechanical connection locking the building panels to each other in a second direction parallel to the principal plane and at right angles to the first and second edges, said locking device fitting within a locking groove extending parallel to and spaced apart from the first edge of said building panels, and which locking groove is open at the rear side of the building panels,

cont.
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the locking device comprising a strip integrated with the second edge of each of said building panels, said strip being provided with a locking element projecting from the strip, such that when two adjacent building panels are joined together, the strip projects from the rear side of the second edge of the panels with its locking element received in the locking groove of an adjacent building panel,

the first and the second mechanical connections both allow mutual displacement of the building panels in a direction of the first and second edges, and

the second mechanical connection enables the locking element to leave the locking groove if the respective building panel is turned about its first edge angularly away from the strip;

wherein the strip is mounted in an equalizing groove which is countersunk in the rear side of each of the building panels and exhibits an exact, predetermined distance from its bottom to the front side of the panel,

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the part of the strip projecting behind the adjacent panel engages a corresponding [equalising] equalizing groove which is countersunk in the rear side of the adjacent panel and which exhibits the same exact, predetermined distance from its bottom to the front side of the adjacent panel, and

the strip has at least such a thickness that the rear side of the strip is flush with the rear sides of the panels.

24. A system as claimed in claim 22, wherein the strip is made of a material different from that of the building panel and fixedly mounted on the building panel at the factory.

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25. A system as claimed in claim 24, wherein the strip is fixed to the building panel by means of a mechanical connection.

26. A system as claimed in claim 25, wherein the mechanical connection between the strip and the building panel comprises a gripping edge defined by two recesses in the rear side of the building panel, and tongues or lips, which are bent or punched from the strip and which press against opposite outer sides of the gripping edge.

27. A system as claimed in claim 25, wherein the mechanical connection between the strip and the building panel comprises a recess in the rear side of the panel,

and tongues or lips, which are bent or punched from the strip and which press against opposing inner sides of the recess.

28. A system as claimed in claim 24, wherein the strip is fixed to the building panel by means of a binder.

cont. 29. A system as claimed in claim 24, wherein the strip is made of a flexible resilient material.

30. A system as claimed in claim 24, wherein the strip is made of sheet aluminum.

31. A system for providing a joint between adjacent building panels, comprising: each of said building panels including a first edge and a second edge such that the first edge of each of said building panels forms a first mechanical connection with the second edge of an adjacent one of the building panels locking the first and second edges of the building panels to each other in a first direction at right angles to a principal plane of the panels, and

a locking device arranged on a rear side of the building panels forming a second mechanical connection locking the building panels to each other in a second direction parallel to the principal plane and at right angles to the first and second edges, said locking device fitting within a locking groove extending parallel to and spaced apart from the first

edge of said building panels, and which locking groove is open at the rear side of the building panels,

the locking device comprising a strip formed at the second edge of each of said building panels, said strip extending throughout substantially an entire length of the second edge and being provided with a locking element projecting from the strip, such that when two adjacent building panels are joined together, the strip projects from the rear side of the second edge of the panels with its locking element received in the locking groove of an adjacent building panel, and

the locking groove and the locking element being dimensioned such that when adjacent panels are joined together and the locking element is received within the locking groove, there is sufficient space within the locking groove to allow mutual displacement of the adjacent panels in a direction of the first and second edges and to enable the locking element to leave the locking groove if the respective building panel is turned about its first edge angularly away from the locking strip.

32. A system as claimed in claim 31, wherein the panels are rectangular and intended, at each of their four edges, to be joined to a similar panel by a first mechanical connection of the aforementioned type and a second mechanical connection of the aforementioned type, each panel having a first pair of first and second edges, one of which is provided with a strip of the aforementioned type and the other of which is provided with a locking groove of the aforementioned type, and a second pair of opposite first and second

edges, one of which is provided with a strip of the aforementioned type and the other of which is provided with a locking groove of the aforementioned type.

33. A system as claimed in claim 31, wherein the strip is made of a material that is different than a remainder of the building panel.

34. A system as claimed in claim 33, wherein the strip is made of aluminum.

35. (Amended) A system as claimed in claim 31, wherein the strip is made of a same material as a remainder of the building panel, and the strip is integrally formed with the building panel. [24. A system as claimed in claim 22, wherein the strip is made of a material different from that of the building panel and fixedly mounted on the building panel at the factory.]

36. A system as claimed in claim 31, wherein the strip is fixed to the building panel by means of a mechanical connection.

37. A system as claimed in claim 36, wherein the mechanical connection between the strip and the building panel comprises a gripping edge defined by two recesses in the rear side of the building panel, and tongues or lips, which are bent or punched from the strip and which press against opposite outer sides of the gripping edge.

38. A system as claimed in claim 36, wherein the mechanical connection between the strip and the building panel comprises a recess in the rear side of the panel, and tongues or lips, which are bent or punched from the strip and which press against opposing inner sides of the recess.

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39. A system as claimed in claim 31, wherein the strip is fixed to the building panel by means of a binder.

40. A system as claimed in claim 31, wherein the strip is made of a flexible resilient material.

Please add the following new claims 41 - 43:

41. (New) The system of claim 13, wherein the strip is made of sheet aluminum.

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42. (New) The system of claim 19, wherein the sealing means is a rubber strip.

43. (New) The system of claim 19, wherein the sealing means is a sealing compound.

REMARKS

Applicant thanks the Examiner for careful examination of this application, and for the helpful suggestions regarding editorial and grammatical errors contained in the application.

By the foregoing amendments, claims 1 - 43 are now pending in this application. No claims have been cancelled. Claims 7, 8, 10, 11, 13, 17, 19, 23, and 35 are amended above, and claims 41 - 43 are newly added.

The Official Action objected to the specification and Claims 7, 8 and 23 because they contain the term "equalising". Accordingly, Applicant has amended the specification and Claims 7, 8 and 23 to replace the term "equalising" with the term "equalizing". Support is inherent in the original specification because the amendments merely change the variant of the spelling.

Also, claim 35 was objected to because Claim 24 was inadvertently included, as a second sentence, after the recitation of Claim 35. To correct this matter, Applicant has deleted the second sentence of Claim 35. Support is also inherent for this correction.

The Official Action rejected various claims under 35 U.S.C. §112. Claims 10, 11, 13, 17 and 19 were rejected because they contain the phrase "or the like" and/or "such as". Accordingly, Applicant has amended claims 10, 11, 13, 17 and 19 to remove such phrases. Support for such amendments is also inherent.

Also, the phrases noted above, "such as" and "or the like", possibly caused Claims 10, 11, 13, 17, and 19 to recite certain aspects of the claimed elements in the alternative. Thus, Applicant has deleted potentially alternate aspects from Claims 10, 11, 13, 17, and

19, and included these aspects of the invention in new Claims 41-43 respectively. Thus, new Claims 41-43 do not extend beyond the original scope of the claims and do not require further searching by the Examiner. Such new claims are supported by the original claims.

Claims 1-3, 5, 10-11, 13, 16-17, 19-27, 29-31, 33-38 and 40 were rejected for non-statutory double patenting over United States Patent Number 6,516,579 to *Pervan*. To overcome this rejection, Applicant submitted a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c) on January 8, 2004.

The Examiner may recall that at the time of the submission of claims 21-23, claim 1 (and the dependent claims based on claim 1) had been allowed over the references of record, one of which was Trotter (US 4,819,932). Based on the Examiner's statement of reasons for allowance of claim 1, the applicant understood that the allowance of claim 1 was not based on the presence of the "play" limitation in claim 1.¹ Since the "play" limitation of claim 1 did not appear to be a basis for the Examiner's allowance of that claim, the Applicant submitted claims 21-23 without any play limitation, believing that such claims would also be patentable over Trotter.

Thus, the limitation calling for play which appears in claim 1 was deliberately eliminated from claims 21-23. It is Applicant's intention to eliminate any ambiguity or question regarding claims 21-23 with respect to the absence of a play limitation. Therefore, the Applicant understands that the patentability of claims 21-23 is being

¹ Applicant notes that Trotter uses the term "play" at Col. 4, lines 19-23. However, claim 1 contains a limitation calling for different kind of play as compared to the play in Trotter. The "play" in claim 1 is in a different location and serves a different purpose than the play disclosed in Trotter.

confirmed in this reissue/reexamination on the basis that those claims claim do not require play. If the Examiner's understanding of the scope of claims 21-23 as confirmed in this application is different from the applicant's intended scope, i.e., as not including a limitation calling for play, Applicant requests that the Examiner so indicate in her reasons for allowance or otherwise.

Applicant believes the application as amended is in form for allowance, and therefore respectfully request that the application be allowed in a timely manner. Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: July 2, 2004

By: William C. Rowland
William C. Rowland
Registration No. 30,888

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Tony Pervan

Application No.: 09/343,696

Filing Date: June 13, 2000

Title: SYSTEM FOR JOINING BUILDING BOARDS

Group Art Unit: 3635

Examiner: Y. Horton

Confirmation No.: 8240

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

Enclosed is a reply for the above-identified patent application.

- ☐ A Petition for Extension of Time is also enclosed.
- ☐ Terminal Disclaimer(s) and the ☐ \$55.00 (2814) ☐ \$110.00 (1814) fee per Disclaimer due under 37 C.F.R. § 1.20(d) are also enclosed.
- ☒ Also enclosed is/are an Information Disclosure Statement

- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$385.00 (2801) ☐ \$770.00 (1801) fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.
- ☐ Applicant(s) previously submitted _____

on _____
for which continued examination is requested.

- ☐ Applicant(s) requests suspension of action by the Office until at least _____ which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

☒ No additional claim fee is required.

☐ An additional claim fee is required, and is calculated as shown below.

AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims	43	MINUS 43 =	0	x \$18.00 (1202) =	\$ 0.00
Independent Claims	5	MINUS 5 =	0	x \$86.00 (1201) =	\$ 0.00
If Amendment adds multiple dependent claims, add \$290.00 (1203)					
Total Claim Amendment Fee					\$ 0.00
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					\$ 0.00
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					\$ 0.00

☐ A check in the amount of _____ is enclosed for the fee due.

☐ Charge _____ to Deposit Account No. 02-4800.

☐ Charge _____ to credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

By



William C. Rowland

Registration No. 30,888

Date: July 2, 2004



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Tony Pervan

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on _____
for which continued examination is requested.

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enclosed.

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- ☐ An additional claim fee is required, and is calculated as shown below.

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Independent Claims	5	MINUS 5 =	0	x \$86.00 (1201) =	\$ 0.00
If Amendment adds multiple dependent claims, add \$290.00 (1203)					
Total Claim Amendment Fee					\$ 0.00
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					\$ 0.00
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					\$ 0.00

- ☐ A check in the amount of _____ is enclosed for the fee due.
- ☐ Charge _____ to Deposit Account No. 02-4800.
- ☐ Charge _____ to credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: July 2, 2004

By William C. Rowland
William C. Rowland
Registration No. 30,888



CERTIFICATE OF SERVICE

It is hereby certified by the undersigned that a true copy of the foregoing Amendment and Information Disclosure Statement were mailed, first-class, postage prepaid, to:

Thomas P. Pavelko, Esq.
Stevens, Davis, Miller & Mosher, LLP
1615 L Street, NW
Washington, D.C. 20036
Attorney for Third-Party Requestor

Attorneys for Patentee, this 2nd day of July, 2004


William C. Rowland

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